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PATENT APPLICATION

**RECEIVED**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 11 2004

**OFFICE OF PETITIONS**

In re Application of:

Birgit SCHLEIFENBAUM, et al.

Conf. No. 8303

Application No.: 09/707,270

Examiner: TRAN LIEN, THUY

Filed: November 6, 2000

Art Unit: 1761

For: ENCAPSULATED FLAVORINGS

Atty. Docket: 3968.027

Customer No.: 000041288

RESPONSE TO ADVISORY ACTION

**Mail Stop Petitions**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Responsive to the Advisory Action issued in the above-captioned case and dated April 24, 2003, the period for response having expired on March 27, 2003, Applicant submits herewith:

1. A Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137(b), which includes the required statement that the entire delay in filing the required response was unintentional;
2. A fee of \$1330 under 37 C.F.R. 1.17(m) for the Petition of item (1);
3. A Request for Continued Examination under 37 C.F.R. §1.114;

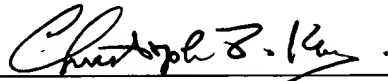
U.S. Application No.: 09/707,270  
RESPONSE TO ADVISORY ACTION  
Attorney Docket: 3968.027

4. A fee of \$770 under 37 C.F.R. 1.17(e) for the Request of item (3); and
5. An executed Declaration Under Rule 37 C.F.R. § 1.132.

The Examiner is respectfully requested to acknowledge receipt of the above documents.

Respectfully submitted,

PENDORF & CUTLIFF  
5111 Memorial Highway  
Tampa, Florida 33634-7356  
(813) 886-6085

  
\_\_\_\_\_  
Christopher J. Kay  
Registration No. 44,820

Date: August 4, 2004

U.S. Application No.: 09/707,270  
RESPONSE TO ADVISORY ACTION  
Attorney Docket: 3968.027

CERTIFICATE OF MAILING AND AUTHORIZATION TO CHARGE

I hereby certify that the foregoing **RESPONSE TO ADVISORY ACTION** for U.S. Application No. **09/707,270** filed **November 6, 2000**, was deposited in first class U.S. mail, postage prepaid, addressed: **Mail Stop Petitions**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on **August 4, 2004**.

The Commissioner is hereby authorized to charge any additional fees, which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 16-0877.

  
\_\_\_\_\_  
Christopher J. Kay



DECLARATION UNDER RULE 132

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Birgit SCHLEIFENBAUM, et al.

Appln. No.: 09/707,270

Group Art Unit: 1761

Filed: November 6, 2000

Examiner: Thuy TRAN LIEN

For: ENCAPSULATED FLAVORINGS

Attorney Docket No.: 3968.027

DECLARATION UNDER 37 C.F.R. § 132

Mail Stop CPA  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I, Dr. Jens Uhlemann, of Holzminden, Germany, do declare and state the following:

In 05 / <sup>May</sup> (month) of 1992 (year), I graduated from the University of \* with a Ph.D. in chemical engineering

I have been involved in research and development relating to flavor and aroma chemistry since 1997 (year), and consider myself an expert in this field.

\* Institut National Polytechnique in  
Toulouse / France

U.S. Application No.: 09/707,270  
DECLARATION UNDER RULE 132

Attorney Docket: 3968.027

I am employed as Director of the Technology Development Center of Symrise GmbH & Co. KG, located at Holzminden Mühlenfeldstraße 1, D-37603 Holzminden, Germany.

I am an inventor of the above-identified application and I am familiar with the subject matter and prosecution history of said application, including the Final Office Action dated November 27, 2002.

I have been personally involved in the development of the presently claimed encapsulated flavorings and am personally aware of the following historical events.

I understand that it is the Examiner's position in the Office Action dated November 27, 2002 that the combination of Porzio et al. (U.S. Patent No. 5,603,971) and Fulger et al. (U.S. Patent No. 5,601,865) renders the subject matter of claims 5-11 of the above-captioned application unpatentable for obviousness.

To the best of my understanding, the Examiner's position is that, although the products of product-by-process claims 5-11 are obtained by treatment with an inert gas at a specified flow rate, a limitation not taught either by Fulger or Porzio, the Examiner

considers that unexpected or superior properties of the presently claimed products have not been demonstrated.

For the following reasons, I designed the comparative experiments described herein to compare the particles prepared in accordance with claims 5-11 with those of the closest known prior art.

Specifically, I designed the comparative experiments described herein to compare the isopropanol content of the particles of claims 5-11 with those of the closest known prior art, which, for reasons provided below, are particles prepared by the method of Fulger including the step of cooling using isopropanol.

I assert that the cited prior art does not teach or suggest treating flavoring particles with *inert gas*, or the *gas velocity* of the inert gas, as recited in the presently rejected claims.

I further assert that the particles of claims 5-11 possess unexpectedly superior properties for at least three reasons:

- (a) the *lack of exposed flavoring on the surface* of the particles when treated with inert gas at the claimed velocity. Thus, as discussed in the specification at

page 2, lines 17-19, in reference to particles of the prior art: "The exposed flavoring on the surface of the particles forms an oily layer on the surface of the particle. This oily layer on the surface causes a marked impairment on the shelf life of particles." In contrast, On page 3, lines 13-15 of the present specification it is disclosed, with reference to the particles of the present invention: "The novel flavoring particles of the present invention are virtually free at the surface from an oily layer from the flavoring used and have a high glass transition temperature. The flavoring is located virtually exclusively in the interior of the particles";

- (b) the *superior storage stability* of particles treated with inert gas at this velocity, in comparison to air, which I attribute to the interior location of the flavoring; and
- (c) the *absence of isopropanol* in the claimed particles when treated with inert gas at the claimed velocity, which results in improved sensory, physical and

toxicological properties of the particle.

Fulger teaches cooling flavoring particles in ambient air on trays, by atmospheric pressure cyclical collection in an ice bath, by cooling in cold 99% isopropanol, or by pressure cooking.

I find that particles obtained by cooling down without inert gas treatment (e.g. ambient air, Fulger) still have a significant amount of flavoring on the surface of the particle (oily layer), which is not desired. So, cooling down the particle with air quickens the cooling process, but fails to minimize the accumulation of flavoring on the surface of the particle.

In contrast, particles obtained by cooling in cold 99% isopropanol (Fulger) are virtually free of flavoring on the surface of the particle.

Accordingly, particles prepared according to the method of Fulger obtained by cooling in cold 99% isopropanol represent the closest known prior art and are therefore appropriate for comparative experimentation.



The following experimentation was conducted by me, or under my direct supervision.

PROCEDURE

I designed the following comparative experiment to compare the particles of claims 5-11 to those of Fulger as prepared by cooling in cold 99% isopropanol.

I compared the isopropanol content of the particles of claims 5-11 to the isopropanol content of particles obtained according to the method taught by Fulger as prepared by cooling in cold 99% isopropanol.

The isopropanol-content was measured by quantitative GC/MS using a conventional method.

When performing experiments as described by Fulger, I found significant amounts of isopropanol in the finished particles. I found that the isopropanol was incorporated in and/or was adhering to the particle. I found up to 700 ppm of isopropanol in the particle either shortly after the drying process, or after storage for 1 day.

I further found that the residual amount of isopropanol in the particles according to Fulger, even after drying and storage

for at least one month at room temperature, remains within the range 100 - 150 ppm (by weight). I concluded that this amount will effectively remain incorporated within the particle. I am aware that such an amount alters the sensory, physical and also the toxicological properties of the particle.

In contrast, I found that the particles according to the present invention have an isopropanol content that is less than 1ppm because isopropanol is not part of the process at all.

Thus, in addition to the unexpectedly superior properties described in (a) and (b) above, I find that the absence of residual isopropanol in the particles of claims 5-11 leads to further unexpectedly superior properties (see (c), above) when compared to the closest prior art particles of Fulger, which I surprisingly found retained isopropanol in amounts that I am aware degrades the sensory, physical and toxicological properties of the particles.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the

U.S. Application No.: 09/707,270  
DECLARATION UNDER RULE 132

Attorney Docket: 3968.027

like so made are punishable by fine or imprisonment, or both,  
under Section 1001 of Title 18 of the United States Code, and that  
such willful false statements may jeopardize the validity of this  
application of any patent issuing thereon.

Date: 11/04/03

J. Uhlemann

Dr. Jens UHLEMANN

#14

**Petition For Revival Of An Application For Patent Abandoned  
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.  
3968.027

In Re Application Of: **Birgit SCHLEIFENBAUM et al.**

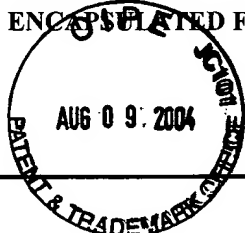
Serial No.  
09/707,270

Filing Date  
November 6, 2000

Examiner  
TRAN LIEN, THUY

Group Art Unit  
1761

Invention: **ENCAPSULATED FLAVORINGS**



**RECEIVED**

AUG 11 2004

**OFFICE OF PETITIONS**

Attention: Office of Petitions  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper response to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extension of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. ☒ A proposed reply to the above-identified notice or action:

☐ is enclosed. ☒ was filed on March 27, 2003

The proposed reply is in the form of: Amendment B, and RCE and Declaration herewith

2. ☐ The issue fee:

☐ is enclosed. ☐ was paid on \_\_\_\_\_

3. ☒ The abandoned application was a:

☐ design application. ☒ utility application. ☐ plant application.

4. ☐ A terminal disclaimer (and fee) disclaiming a period equivalent to the period of abandonment is enclosed.

5. ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

08/10/2004 AWDHDAF1 00000048 09707270

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**Petition For Revival Of An Application For Patent Abandoned  
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Docket No.  
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Serial No.  
09/707,270

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November 6, 2000

Examiner  
TRAN LIEN, THUY

Group Art Unit  
1761

Invention: **ENCAPSULATED FLAVORINGS**

**Calculation and Payment of Fees**

Enclosed are the following fees:

- |   |                             |
|---|-----------------------------|
| 6. <input checked="" type="checkbox"/> Petition fee under 37 CFR 1.17(m) in the amount of:          | <u>\$1,330.00</u>           |
| 7. <input type="checkbox"/> Fee for amendment in the amount of:                                     | <u>                    </u> |
| 8. <input type="checkbox"/> Fee for extension of time to respond to Office Action in the amount of: | <u>                    </u> |
| 9. <input type="checkbox"/> Issue fee in the amount of:   | <u>                    </u> |
| 10. <input checked="" type="checkbox"/> Continuing application filing fee in the amount of:         | <u>\$770.00</u>             |
| 11. <input type="checkbox"/> Terminal disclaimer fee in the amount of:                              | <u>                    </u> |
| 12. <input type="checkbox"/> _____  | <u>                    </u> |
| Total fees enclosed: <u>\$2,100.00</u>  |                             |

The fee of **\$2,100** is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **16-0877**

**Petition For Revival Of An Application For Patent Abandoned  
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.  
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In Re Application Of: **Birgit SCHLEIFENBAUM et al.**

Serial No.  
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November 6, 2000

Examiner  
TRAN LIEN, THUY

Group Art Unit  
1761

Invention: **ENCAPSULATED FLAVORINGS**

**Statement**

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

  
*Signature*

Dated: August 4, 2004

**Christopher J. Kay**  
Registration No. 44,820

I certify that this document and fee is being deposited  
on **August 4, 2004** with the U.S. Postal Service as  
first class mail under 37 C.F.R. 1.8 and is addressed to the  
Assistant Commissioner for Patents, Washington, D.C.  
20231.

  
*Signature of Person Mailing Correspondence*

**Christopher J. Kay**

*Typed or Printed Name of Person Mailing Correspondence*

CC: